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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,025	03/18/2002	Ulrich Jordis	W5-127001A.30	8211

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EXAMINER

OWENS, AMELIA A

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,025

Applicant(s)

JORDIS ET AL.

Examiner

Amelia A. Owens

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Due to the numerous variables in the claims, e.g. R1 thru R5, G1 thru G3, W, T, U, V, X, Y, Z etc., and their widely divergent meanings, a precise listing of inventive groups cannot be made. The following groups are exemplary:

Group I. Claim 1 (in-part) drawn to products wherein W is CR13 (R14); R1/R2/R3 independently are a, b, e-i; R4/R5 are hydrogen, b (i)

Group II. Claim 1 (in-part), drawn to products wherein W is CR13 (R14) R1/R2/R3 independently is c; R4/R5 are b (ii)

Group III. Claim 1 (in-part), drawn to products wherein W is N-phenyl; R1/R2/R3 independently are a, b, e-i; R4/R5 are hydrogen, b (i)

Group IV. Claim 1 (in-part), drawn to products wherein W is N-phenyl R1/R2/R3 independently is c; R4/R5 are b (ii)

Group V. Claim 2 (in-part), drawn to products wherein W is CR13 (R14); R1/R2/R3 independently are a, b, e-i; R4/R5 are hydrogen, b (i); D is N

Group VI. Claim 2 (in-part), drawn to products wherein W is CR13 (R14); R1/R2/R3 independently are a, b, e-i; R4/R5 are hydrogen, b (i); D is oxygen

Group VII. Claim 2 (in-part), drawn to products wherein W is CR13 (R14); R1/R2/R3 independently are a, b, e-i; R4/R5 are hydrogen, b (i); D is sulfur

Group VIII. Claim 2 (in-part), drawn to products wherein W is N-phenyl; R1/R2/R3 independently are a, b, e-i; R4/R5 are hydrogen, b (i); D is N

Group IX. Claim 2 (in-part), drawn to products wherein W is N-phenyl; R1/R2/R3 independently are a, b, e-i; R4/R5 are hydrogen, b (i); D is oxygen

Group X. Claim 2 (in-part), drawn to products wherein W is N-phenyl; R1/R2/R3 independently are a, b, e-i; R4/R5 are hydrogen, b (i); D is sulfur

Group XI. Claim 3 (in-part), drawn to products wherein W is CR13 (R14); R1/R2/R3 independently are a, b, e-i; R4/R5 are hydrogen, b (i); XR16

Group XII. Claim 4 (in-part), drawn to products wherein W is CR13 (R14); R1/R2/R3 independently are a, b, e-i; R4/R5 are hydrogen, b (i)

Group XII. Claim 4 (in-part), drawn to products wherein W is N-phenyl; R1/R2/R3 independently are a, b, e-i; R4/R5 are hydrogen, b (i)

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. Again, this list is not exhausted, as it would be impossible under the time constraints due to the sheer volume of subject matter instantly claimed. Therefore, applicant may choose to elect a single invention by identifying another specific embodiment not listed in the exemplary groups of the invention and the examiner will endeavor to group the same. This includes an exact definition of each substitution on the base molecule (Formula #), wherein a single member at each substituent group or moiety is selected. For example, if a base molecule has a substituent group R1, wherein R1 is recited to be any one of H, OH, COOH, aryl, alkoxy, halogen, amino, etc., then applicant must select a single substituent of R1, for example OH or aryl, and each subsequent variable position. In the instant case, upon election of a single compound (or set of compounds), the Office will review the claims and disclosure to determine the scope of the independent invention

encompassing the elected compound (compounds which are so similar thereto as to be within the same inventive concept and reduction to practice). The scope of an independent invention will encompass all compounds within the scope of the claim which fall into the same class and subclass as the elected compound (or set of compounds), but may also include additional compounds which fall in related subclasses. Examination will then proceed on the elected compound AND the entire scope of the invention encompassing the elected compound as defined by common classification. A clear statement of the examined invention, defined by those class(es) and subclass(es) will be set forth in the first action on the merits.

The claims herein lack unity of invention under PCT Rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The compounds claimed contain a benzofuran ring which does not define a contribution over the prior art. The substituents on the structure vary extensively and when taken as a whole result in vastly different compounds. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper.

Additionally, the vastness of the claimed subject matter and the complications in understanding the claimed subject matter imposes a burden on any examination of the claimed subject matter.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia A. Owens whose telephone number is 571-272-0690.

The examiner can normally be reached on Monday - Friday from 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Amelia A. Owens
Primary Examiner
Art Unit 1625